



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/224,027	12/31/1998	JOSEPH AUGUST GIORDANO	PE-95-13-(55	4204

7590 09/12/2006

DAVID L MCCOMBS  
HAYNES AND BOONE  
3100 NATIONSBANK PLAZA  
901 MAIN STREET  
DALLAS, TX 752023789

EXAMINER
----------

POINVIL, FRANTZY

ART UNIT	PAPER NUMBER
----------	--------------

3628

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/224,027

Applicant(s)

GIORDANO ET AL.

Examiner

Frantzy Poinvil

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25,27-32,50-57 and 59-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25,27-32 and 50-57 is/are allowed.
- 6) ☒ Claim(s) 59-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date: _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/17/04 &amp; 7/19/02</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 59 is objected to because of the following informalities:

As per claim 59, line 2, "idtification" appears to be a typographical error. The examiner suggests replacing "idtification" to - -identification- -.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. Claims 59-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 59, line 7, the first occurrence of "transponder" is referred back to the previously recited "hand-held transponder" on line 2. It is unclear how the transponder recited on line 7 now recites the "transponder comprises a handheld transponder".

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 59-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Randelman et al (US Patent No. 5,072,380).

As per claims 59, 65 Randelman et al disclose a system and method for authorizing a dispensing transaction comprising the steps of:

Determining whether an electronic card having an emitter containing customer identification is within a range of a dispenser, the dispenser comprises a fuel dispenser requiring activation by the customer to initiate a transaction and including a reader associated therewith for emitting radio frequency signals within the dispenser range, and for receiving customer identification data from the card responsive to the emitted radio frequency signals received by the transponder, wherein the card contains customer identification data;

Determining whether the dispenser has been activated by the customer following the determination that the emitter is within the dispenser range; and

Upon activation of the dispenser following the determination that the card with the emitter is within the dispenser range, associating the customer identification data received by the reader with a transaction at the activated dispenser, whereupon the transaction at the activated dispenser is permitted and charged to the customer according to the customer identification data, wherein the reader is provided with a first antenna that is adapted to emit and receive radio frequency signals within the dispenser range, wherein the receipt of radio frequency signals includes receiving customer identification data.

Applicant is directed to column 3, line 34 to column 4, line 59.

The only difference between the claimed invention and the system of Randleman is that the system of Randleman uses an emitter card whereas the claimed invention is claiming a portable handheld transponder. As per this minor obvious difference, it is noted that the claimed transponder performs similar functions as the emitter card of Randleman. Thus, there exists only a change in label which does not attribute to any patentable differences.

Claims 60-64 are directed to the billing of the customer's account upon a valid authorization of the customer's account which must contain sufficient funds to enable a current transaction (such as dispensing fuel) to take place. As per these limitations, the examiner asserts that card authorization is well known in the art and usually involves a card issuer or bank authorizes a payment for a particular transaction if there exists a sufficient fund in the cardholder's or customer's account. Randelman et al teach cross-checking or validating credit of a customer's account before allowing a transaction to take place. Thus, performing the functions of claimed 60-64 in Randleman et al would have been obvious to one of ordinary skill in the art to do for payment processing purposes.

As per claim 66, Randleman et al disclose querying if a vehicle approaches a fuel dispenser when the vehicle having the card with the emitter is in the vicinity of a gas station. See column 3, lines 56-67.

As per claim 67, see column 3, line 59 to column 4, line 19 of Randleman et al.

Art Unit: 3628

***Allowable Subject Matter***


4. Claims 25, 27-32, 50, 51 and 53-57 are allowable over the art of record.

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday from 7:30AM to 6:00PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached at (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
**Frantzy Poinvil**  
**Primary Examiner**  
**Art Unit 3628**

FP  
August 31, 2006